REMARKS

Reconsideration of the Office Action mailed June 30, 2004, (hereinafter "instant Office Action"), entry of the foregoing amendments and withdrawal of the rejection of claims 1-8, 10, 46 and 47, are respectfully requested.

In the instant Office Action, claims 1-8, 10, 11 and 46-52 are listed as pending, claims 11 and 48-51 are listed as withdrawn from consideration, claims 1-8, 10, 46 and 47 are listed as rejected and claim 52 is listed as allowed.

Claim 6 has been amended to correct a typographical error.

The Examiner has rejected claims 1-8, 10 and 47 under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as his invention. The Examiner notes that in the definition of R_c, the term $-W-(CH_2)_t)-NR_dR_e$ is confusing because there is a mismatch in the parenthesis. Applicants have amended claim 1 so that "$-W-(CH_2)_t)-NR_dR_e$" is amended to "$-W-(CH_2)_t-NR_dR_e$".

The Examiner also notes that in claim 1, in the definition of R_c, the recitation "$-W-(CH_2)_t-NR_dR_e$, $-W-(CH_2)_t-O$-alkyl, $-W-(CH_2)_t-S$-alkyl, $-W-(CH_2)_t-OH$ or" is repeated. Applicants have amended claim 1 to delete the repeated phrase.

The Examiner notes that in claim 1, in the definition of L, the terms "-N(R)S(O)N(R)-; $N(R)S(O)_2N(R)$-" are repeated. Applicants have amended claim 1 to delete the repeated phrase.

Based upon the foregoing amendments, the rejection of claims 1-8, 10 and 47 under 35 U.S.C. §112, second paragraph, is obviated and should be withdrawn.

The Examiner has rejected claims 1-8, 10 and 47 under 35 U.S.C. §102(a) as allegedly being anticipated by Calderwood et al., WO 98/41525. The Examiner states that "[t]he instantly claimed compounds read on the compounds of the reference, see formula (I) and the species, e.g., page 14, lines 9-14, 22-23, etc. Applicants have amended claim 1 to exclude the compounds listed at page 13, lines 4-5 and 7-9, and page 14, lines 5-14, 22-23 and 25-26.

Based upon the foregoing, the rejection of claims 1-8, 10 and 47 under 35 U.S.C. §102(a) over Calderwood et al., WO 98/41525, is obviated and should be withdrawn.

The Examiner has rejected claims 1-8, 10 and 47 under 35 U.S.C. §102(e) over U.S. Patent No. 6,001,839. The Examiner stated that "[t]he instantly claimed compounds read on the compounds of the reference, see formula (I) and the species, e.g., col. 10, lines 5-15, 26-27, 30-31, etc. Applicants have amended claim 1 to exclude the compounds listed at column 9, lines 19-22, and lines 24-27 and column 10, lines 5-15, 26-27 and 30-31. Applicants respectfully point out that these are the same compounds listed at page 13, lines 4-5 and 7-9, and page 14, lines 5-14, 22-23 and 25-26 in WO 98/41525, so that a total of eleven compounds have been excluded from claim 1.

Based upon the foregoing, the rejection of claims 1-8, 10 and 47 over 35 U.S.C. §102(e) over U.S. Patent No. 6,001,839 is obviated and should be withdrawn.

The Examiner has rejected claims 1-8, 10, 46 and 47 under 35 U.S.C. §103(a) over Calderwood et al., WO 98/41525. Applicants respectfully traverse this rejection. The Examiner has not established a *prima facie* case of obviousness. In order to establish a *prima facie* case of obviousness, there must be some suggestion or motivation to modify the reference. The reference does not provide any suggestion or motivation to modify WO 98/41525 to arrive at Applicants' genus.

In making a *prima facie* obviousness determination, an invention must be considered as a whole. In determining the differences between the prior art and the claims, the question under 35 U.S.C. §103 is not whether the differences themselves would have been obvious, but whether the claimed invention as a whole would have been obvious. Stratoflex, Inc. v. Aeroquip Corp., 713 F.2d 1530, 218 USPQ 871 (Fed. Cir. 1983); Schenck v. Nortron Corp.,713 F.2d 782, 218 USPQ 698 (Fed. Cir. 1983).

The Examiner has not shown that WO 98/41525 provides any suggestion or motivation to one of ordinary skill in the art to make Applicants' genus as it appears in claim 46. Nor has the Examiner shown that WO 98/41525 teaches or suggests all the variables of Applicants' genus as it appears in claim 46.

Based upon the foregoing, the rejection of claims 1-8, 10, 46 and 47 under 35 U.S.C. §103(a) over Calderwood et al., WO 98/41525, is obviated and should be withdrawn.

Applicants acknowledge that the Examiner has advised Applicants that "...should claim 6 be found allowable, claim 7 will be objected to under 37 CFR 1.75 as being a substantial duplicate thereof....Claim 7 does not further limit the scope of claim 6".

Applicants gratefully acknowledge that claim 52 is allowed.

In view of the foregoing amendments and remarks, Applicants believe that claims 1-8, 10 and 46-52 are in condition for allowance. Prompt and favorable action is earnestly solicited.

If the Examiner believes that a telephone conference would advance the condition of the instant application for allowance, Applicants invite the Examiner to call Applicants' agent at the number noted below.

Respectfully submitted,

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